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**D E C I S I O N**  
**of 31 May 2005**

**Case Number:** J 0026/03 - 3.1.1

**Application Number:** 02380130.1

**Publication Number:** -

**IPC:** E04F 11/18

**Language of the proceedings:** EN

**Title of invention:**  
Removable modular urban railing

**Applicant:**  
Trenzametel, S.L.

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 122  
EPC R. 31  
RRF Art. 2 No. 15

**Keyword:**  
"Payment of claims fee within the time limit (no), restitutio  
in integrum - all due care (no)"

**Decisions cited:**  
D 0006/82, G 0003/91

**Catchword:**  
-



Case Number: J 0026/03 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 31 May 2005

**Appellant:** Trenzamental, S.L.  
Santa Clara, 7 - 3  
49003 Zamora (ES)

**Representative:** Manzano Cantos, Gregorio  
Cabinet Manzano  
Embajadores, 55  
28012 Madrid (ES)

**Decision under appeal:** Decision of the European Patent Office not to re-establish the Appellant's right to pay the claims fee due for the twelfth claim of its application and that therefore the twelfth claim is deemed to be withdrawn posted on 4 February 2003.

**Composition of the Board:**

**Chairman:** J. Saisset  
**Members:** U. J. Tronser  
P. Mühlens

## Summary of Facts and Submissions

- I. The appeal lies against the decision of the European Patent Office not to re-establish the Appellant's right to pay the claims fee due for the twelfth claim of its application and that therefore the twelfth claim is deemed to be withdrawn.
- II. The European patent application 02 380 130.1 was filed on 18 June 2002 containing 12 claims.
- III. With a communication pursuant to Rule 31(1) EPC dated 23 July 2002 the European Patent Office informed the Appellant that the claims fees due "for the claims 11 to 012" were not paid within one month after the filing of the application. But that they may still be validly paid within a period of grace of one month after notification of this communication. If only some of the claims fees due were paid, an indication must be given of the claims to which the payment relates. If the claims fee for any claims was not paid in due time the claim concerned should be deemed to be abandoned.

The last paragraph of the communication goes as follows:" The present amount of the fee (s) for the eleventh and each subsequent claim is: 40 EUR".

- IV. On 7 August 2002 an amount of 40 EURO was paid. With a letter related to this payment the Appellant's representative gave the indication that this fee was for the eleventh claim.
- V. Having received the European Patent Office's notification (dated 1 October 2002) that the twelfth

claim was deemed to be abandoned due to the non-payment of the prescribed fee the Appellant's representative filed a request for re-establishment of rights with the European Patent Office on 10 October 2002. He paid the prescribed fee and the claims fee for the twelfth claim. He argued that the fee for only one claim was paid due to the defective interpretation of the amount stated in the communication dated 23 July 2002.

VI. Caused by a further communication of the European Patent Office the Appellant's representative completed its arguments as follows:

It had been always his intention to maintain claim 12 of the application. Having adopted the punctual proceedings of 7 August 2002 it had obviously been his intention to remedy the initial omission to pay the claims fees. Article 122 EPC was providing the possibility to correct this kind of errors.

VII. With decision dated 4 February 2003 the European Patent Office rejected the request for a re-establishment of the twelfth claim and stated that the twelfth claim is deemed to be withdrawn. European Patent Office held that in the letter related to the payment of 7 August 2002 the Appellant's representative had clearly stated that the payment was for the eleventh claim. Therefore there was no reason for the European Patent Office to contact him for clarification. In its request for re-establishment the representative had mentioned that the failure to pay for the twelfth claim was due to a defective interpretation of the amount stated in the communication dated 23 July 2002. But he had not contacted the European Patent Office for advice on this

matter. Thus the representative's due care had not been demonstrated and no information had been provided regarding the measures taken to ensure that the payment of the twelfth claim fee was paid before the expiry of the time limit in question.

VIII. The Appellant lodged an appeal on 1 April 2003 together with payment of the prescribed appeal fee. In its statement of the grounds of appeal filed on 21 May 2003 he argued as follows:

Said claim 12 was not a main claim having vital importance for the patent's contents. But the decision under appeal had construed Article 122 EPO in a non-acceptable way. For it was not required to have larger arguments to reason out the situation deriving from the lack of payment of a claims fee more than a simple and easy labour error, the value of which (EUR 40) did not justify the administrative and juridical development deployed in this case. The omission and misinterpretation had incurred in a simple "form defect", which only affects to own intrinsic or material rights of the patent itself without damaging any alien rights.

The "diligence" previewed under Article 122 EPC had been sufficiently proved by his part for he had punctually answered all the European Patent Office's requirements proposed on this case and accepted its proposal to apply for the reinstatement of his rights.

Moreover the construe made of the communication dated 23 July 2002 in regard with Rule 31(1) EPC had been clearly defective, because even if the paragraph before

last refers to "the eleventh and each subsequent claim", without making any precision, it was not lesser the truth that the first line of second paragraph states "for the claims 11 to 012", therefore the mistake was committed when at time of filing the "bordereau" it was omitted to do so for both claims, consequently the subsequent mistake took place in the letter related to this payment.

- IX. On 14 January 2004 the Board sent the Appellant a communication containing a provisional opinion set out in substantially the same terms as the Reasons below and directing the Appellant to file any comments.
- X. With its answer the Appellant in substance reiterated its view and held that the situation was perfectly remediable in line with what Article 121 EPC enacts, since the intention to go ahead with the proceedings was implicitly declared in its application for "Restitutio in integrum" of October 10, 2002, the fees for which are equivalent in both function and amount to "fee for further processing". Furthermore he argued that the situation was extremely strict should he take into consideration Rule 85 a EPC in regard with the there mentioned fees by burdening them with a simple surcharge when in delay and since in the present case it has been complied with and charged with the penalty implied in the "Restitutio in integrum".
- XI. The Appellant requests:

The decision under appeal be set aside and the request for re-establishment of the twelfth claim be granted.

## Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. As already set out in the Board's communication dated 14 January 2004 the request for re-establishment of the Appellant's right to pay the claims fee due for the twelfth claim of its patent application meets all formal requirements (see Article 122(2) and (3) EPC) and is therefore admissible too.
3. The Appellant however failed to show that the time limit for payment of the claims fee for the twelfth claim according to Rule 31 first paragraph, third sentence EPC was missed in spite of all due care required by the circumstances having been taken. This precondition on the merits of a request for restitutio in integrum being explicitly governed in Article 122(1) EPC.
4. The time limits for payment of claims fees are stipulated by Rule 31 first paragraph, second and third sentences EPC to attain the goal laid down in Rule 29(5) EPC that the number of claims must be kept within reasonable bounds to avoid an undue burden of the public. Hence Rule 31(1) EPC prescribes that a claims fee, the amount of which is set out in Article 2 No. 15 of the Rule relating to Fees (RRF), must be paid for each claim from the eleventh onwards. The claims fee is payable along with the filing fee. If the claims fees had not been paid in due time they may still be validly paid within a period of grace of one month after the

- notification of a communication of the European Patent Office according to Rule 31 first paragraph, third sentence EPC. Otherwise the claim concerned shall be deemed to be abandoned (Rule 31 second paragraph first sentence EPC).
5. Article 122 EPC provides an applicant for or proprietor of a European patent with means to overcome this automatic loss of rights. But besides formal requirements ruled in Article 122(2) und (3) EPC the basic requirement is the above cited (see point 3) all-due-care-issue, having been specified by extensive case law of the Boards of Appeal as the Board has already pointed out and cited in the communication dated 14 January 2004.
  6. Neither with its statement of the grounds of appeal nor with its answer submitted to the Board's communication the Appellant had submitted any facts to allow the conclusion that the omission to pay the claims fee for the twelfth claim in due time was the consequence of an inevitable error and not of a simple overlooking of the provisions applicable (i.e. Rule 31(1) EPC and namely Article 2 No. 15 RRF), or as suggested by the letter related to the payment on 7 August 2002, that at this time it was in fact intended to pay only the claims fee due for the eleventh claim but later on the Appellant wished to keep the twelfth claim too as a consequence of a change of motivation.
  7. In its communication the Board however had already pointed out that persons engaged in proceedings before or involving the European Patent Office must acquaint themselves with the relevant procedural rules (see



D 6/82 OJ EPO 1983, 33f) and that this namely applies to a professional representative.

As to the motivation for the payment suggested by the letter relating to the payment only of the claims fee due for the eleventh claim a professional representative must be aware that the procedural instrument of restitutio in integrum according to Article 122 EPC does not provide any means for further proceeding due to a change in motivation but to overcome a loss of rights as the consequence of the non-observance of a time limit due to an inevitable error caused by exceptional circumstances or by an isolated mistake within a normally satisfactory monitoring system.

8. As to the reference to Article 121 EPC in the Appellant's answer to the communication of the Board it is true that the legal remedy of further processing of the application (Article 121 EPC) pursues the same purpose as restitutio, but it is under the current version of Article 121 EPC depending on different requirements and only available to the applicant (i.e. not to a patent proprietor in opposition proceedings), with regard to time limits set by the European Patent Office (i.e. not by the regulations of the EPC) and when rights have been lost to the application as a whole (see Singer/Stauder, EPC, 3rd Edition, Volume 2, Article 121, 6 and Article 122, 19).
9. Keeping in mind that Rule 31 first paragraph, third sentence EPC provides an applicant not having paid claims fees being payable (i.e. within one month after the filing of the application) with the possibility to

pay them validly within a period of grace of one month after the notification of a communication of the European Patent Office, the Board cannot see any inequity with regard to Rule 85a(1) EPC, a provision ruling the same (but with surcharge) for the filing fee, the search fee or a designation fee, fees being excluded from restitutio in integrum (see Article 122(5) EPC; see also G 3/91 OJ EPO 1999, 8f).

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset